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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,121

01/14/2004

Yutaka Tohgi

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7590

10/02/2006

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EXAMINER

WARREN, DAVID S

ART UNIT

PAPER NUMBER

2837

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/757,121

Applicant(s)

TOHGI ET AL.

Examiner

David S. Warren

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date  
:1/14/04,8/12/04,5/31/05,7/13/06.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8, 12, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 8, 12, 19, and 20, it is unclear as to how the *same* information can be used as the first management information and the second management information, especially since these are expected to elicit two different outcomes. For the rejection below, the Examiner is interpreting this to mean that the first and second management information are of the same *type*, e.g., a similar format. Also in these claims, as written, it appears that “regular use” indicates both an allowability and a non-allowability. The Examiner is interpreting “allowability/non-allowability” as meaning that a determination is made to either allow regular use or trial use (i.e., non-allowability). In other words, the first management information seems to impart a trial use (i.e., non-allowable) of the content and regular use seems to impart full use as well as non-allowable use. Clarification is required.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Without being embedded on a computer-readable medium, a computer program per se has been held to be non-statutory. As per MPEP 2106 (IV)(B)(1)(a), the claims must positively recite a “computer-readable medium.” For example, claims 13 and 14 could read as “[a] computer program embedded on a computer-readable medium containing a group of instructions to cause a computer of a client apparatus...” etc.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 9, 13, 14, 15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al. Regarding claims 1, 9, 13, 14, 15, and 17, Stefik discloses both a client and server apparatus and computer program embedded on a computer-

readable medium therefore (fig. 19, col. 5, lines 31 – 35), wherein digital content is supplied from a supplier having a first management information for allowing trial use (102, fig. 1; col. 46, lines 50 – 61), a user may select normal (i.e., full) usage (col. 46, lines 44 – 48), receive from a server a second management information to allow “normal” (i.e., full, allowability) use, where Stefik et al. states (col, 11, paragraph at line 11):

If the usage rights will be the same for an entire digital work, they could be attached when the digital work is processed for deposit in the digital work server. In the case of a digital work having different usage rights for the various components, this can be done as the digital work is being created.

(The Examiner maintains that “different usage rights” correspond with first management information - i.e., trial or limited access - and second management information corresponds to full or “normal” use.), and wherein the first information management data is replaced by the second management information by the server (see the paragraph bridging cols. 35 and 36). Regarding claims 2 and 16, Stefik discloses reproducing the content on a client apparatus (col. 34, lines 53 – 55). Regarding claims 3, 6, 7, and 10, Stefik discloses encrypting/decrypting from the supplier (claim 6) and server (claim 7), Stefik states that “[t]ransactions require that there be some communication between repositories...the communication line is assumed to be unsecure, all communications with repositories that are above the lowest security class are encrypted utilizing a public key encryption technique.” In claims 3 and 10, the use of “predetermined information specific to [the] client as an encryption/decryption key is deemed to be inherent (i.e., keys come in pairs, writing keys encrypt and private checking keys decrypt; the checking key is located on the client, also this is deemed to be a “common key” since

the key protocol is commonly shared by the server and client, or supplier and server) – see the paragraph bridging cols. 26 and 27. Regarding claims 4 and 5, the “limited use” data (i.e., the first management information) is sent from the server to the client (i.e., it is “connected to [the] server apparatus [and] the communication network – and any recording medium on a client is deemed to be removable). Regarding claims 8, 12, 19, and 20, as best as can be understood (see §112 discussed supra wherein the limitations of these claims are very difficult to understand), this limitation appears to be synonymous with Stefik’s Abstract, specifically, that limitations can be imposed on content, and that those limitations can include “allowability” and “non-allowability” (as well as intermediate limitations, such as copy, print, etc.).

### ***Information Disclosure Statement***

The Information Disclosure Statement received July 31, 2006 did not contain the indicated English translations of two patent documents from China. The Information Disclosure Statement received August 12, 2004, contained non-patent literature without an English translation and was, therefore, not considered by the Examiner.

### ***Conclusion***

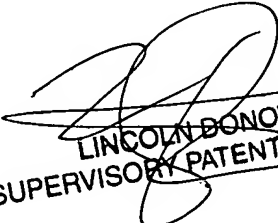
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The document to Ginter et al. (20020112171) also anticipates

Applicant's invention. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Warren whose telephone number is 571-272-2076. The examiner can normally be reached on M-F, 9:30 A.M. to 6:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lincoln Donovan can be reached on 571-272-2837. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dsw

  
LINCOLN DONOVAN  
SUPERVISORY PATENT EXAMINER